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EXAMINER

IRSHADULLAH, M

ART UNIT

PAPER NUMBER

3623

DATE MAILED: 05/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/187,749

Applicant(s)

UTSUMI ET AL.

Examiner

M. Irshadullah

Art Unit

3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

1. This communication is in response to the amendments filed February 28, 2003.

***Summary Of Instant Office Action***

2. Applicant's arguments, filed February 28, 2003, concerning claims 1-9 rejections, para 6, Paper No. 21, Office Action mailed November 01, 2002 have been considered, deemed unpersuasive and the prior rejection is maintained.

3. Applicant's amendments to claims 1-2, 5-6 and 8-9 have been entered.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ross et al ( US Patent 5,553,139 ) in view of Hasebe et al ( US Patent 5,392,351 ).

Ross et al disclose:

**Claim 1.** A license devolution apparatus ( Title and col. 1, lines 7-8 )

a) storage medium accessing means (col. 1, line 55, wherein recitation of “accessible” points to availability of “accessing” function in the reference and said function clearly infers presence of “device, such as CD rom drive” (means for accessing storage medium (CD, col. 1, line 46-47), for accessing a first storage medium storing contents encrypted with a predetermined key ( Col 1, line 55, recited with lines 52-53, Fig. 6B described col. 1, lines 46-51, Fig. 5 ( Enabler Keys ), Fig. 2 ( 210, 216, 218 ) recited with col. 6, lines 1-3, 8-13, 16 and 19-20. It needs be mentioned that the use of a predetermined (enabler) key or a key generated during encryption process are notoriously known in the art under discussion ), a first media ID identifying the first storage medium ( Please see discussion below ), and a first encryption secure information generated by encrypting the key and a first license information (Col. 3, lines 21-24 (a serial number, number of connections, major and minor product version identifiers, ten random numbers and three checksum values) and lines 40-41 (the product and licensing combinations) clearly infer claimed “license information” and it would be considered “first” when used by initial or first entity, such as manufacturer, Fig. 5 (1)), representing a right to use the contents (Col. 3, lines 44-45, wherein “product and license installed on end user’s system” infers that end user would then have the right to use the information (content) on the medium (CD rom etc.), together with one another or individually (Reference’s “storing” function would be used for storing “content” either with first media ID or both first and second media IDs using IDs discussed below), with the first media ID, and accessing a second storage medium, storing a second media ID identifying the second storage medium ( Please see discussion below ); yet

Ross et al do not show:

- a first media ID, identifying the first storage medium,
- (storing) a second media ID identifying the second storage media.

However, Hasebe et al teach the same ( Fig. 2 (12) described col. 2, lines 10-12, col. 9, lines 1-9 ).

It would have been obvious to one of ordinary skill in the license/information protection art at the time of applicant's invention to include Hasebe et al's media IDs in Ross et al's invention, because it would provide additional/enhanced protection to electronic data/information in addition to copyright protection.

b) decoding means for decoding the first encryption secure information stored in said first storage medium using the first media ID to obtain the key and the first license information ( Ross et al: Col. 4, lines 22-24, col. 6, lines 40-59 (specifically lines 49, 52-56), col. 7, lines 28-40, 47-55, Fig 4 described col. 7, lines 56-65 continue col. 8, lines 5-8, and Fig. 7 ( C, D, E ), see discussion about "first license information" and discussion about media ID in 1a) above ); and

c) encryption means for encrypting the key and a second license information, representing a second right to use the contents that is devolved from the first license information stored on the first storage medium to the second storage medium together with one another or individually (as discussed above in 1a) above) with the second media ID, to generate a second encryption secure information with the second media ID for storage in said second storage medium (Ross et al: Fig 2 (210, 218), Fig. 5 (A, B),

Art Unit: 3623

col. 3, lines 17-24, col. 6, lines 40-49 and 51-52 recited with col. 4, lines 8-15, col. 3, lines 34-45 and col. 7, lines 32-55, and discussion about media ID in 1a above).

**Claim 2.** A license devolution apparatus according to claim 1, wherein said encryption means encrypts with the first media ID a third license information, obtained through subtracting the second license information from a first license information, or encrypts with the first media ID both the key and the third right of using, to generate a third secure information and stores the third encryption secure information in the first storage medium ( Ross et al: Fig. 2 ( 210, 218 ), Fig 5 ( A, B ), Fig. 5 ( any of 2-4 would be considered as third user of the third right of using and obtained by eliminating/subtracting the second right of using from the first right of using ) and col. 3, lines 40-45, see discussion about "licensing information" and discussion about "media ID" in claim 1a) above. Moreover, the license information would first, second, third etc. when used by any of 1-4 entities of Ross et al's Fig. 5).

**Claim 3.** A license devolution apparatus according to claim 1, wherein if the entire rights of using the contents, to which the first storage medium is entitled, are devolved to the second storage medium ( Claim 1, lines 37-41, coll. 4, lines 8-15 and col. 6-col 7(up to line 20 ) ), the first encryption secure information stored in the first storage medium is destroyed ( Ross et al: Fig. 1 ( 102 ), col. 4, lines 16-18. Applicant will appreciate that reference's disabling function/process would be used to

Art Unit: 3623

disable/erase/delete/destroy the secure information stored in the first storage medium after transferring the information to another/second etc. media ).

**Claim 4.** A license devolution apparatus according to claim 1, wherein before devolution of the right to use the contents, the first storage medium stores contents whose right to use is intended to be devolved as encrypted contents ( Figs. 6A and 6B described col. 1, lines 31-61 ), and

wherein said license devolution apparatus further comprises contents transfer means for reading the encrypted contents from the first storage medium, and storing in the second storage medium the read encrypted contents ( Claim 1, lines 37-41.

Reading devices, like diskette or CD drives are inherently implied ).

**Claim 5.** A license devolution apparatus according to claim 2, wherein the first license information and the second license information represent the presence of the right to use, and the third license information represents the absence of the right to use ( Fig. 5, any of 2-4 would be a first (user) of first use information, a second (user) of second use of information and when two are using the use information, third one ( say, installer ) would be unable/absent to have the right of using the use information unless the use information is transferred/distributed/devolved simultaneously to all, see discussion about license information in claim 1a) and 2) above ).

Art Unit: 3623

**Claim 6.** A license devolution apparatus according to claim 2, wherein the first license information represents of a first available number of times or available time, the second license information is represents a second available number of times or available time which is less than the first available number of times or available time, and the third license information represents a third available number of times or available time which is obtained through subtracting the second available number of times or available time from the first available number of times or available time ( Inherent, since the user under the agreement would be obliged to use the product ( document, picture or program ) for certain number of time(s) and when one user would transfer/devolve the right of use, he could only do so for the remainder of one's available number of times and see discussion about license information in claim 1a) and 2) above ).

**Claim 7.** A license devolution apparatus according to claim 1, further comprising a first drive and a second drive driving the first storage medium and the second storage medium, respectively, said first drive and said second drive having a first firmware and a second firmware accessing the first storage medium and the second storage medium, respectively ( Inherent, since the diskette or CD or other media drives have their respective drivers or softwares/firmwares for running the same ),

wherein said decoding means and said encryption means are arranged in a firmware consisting of said first firmware and said second firmware in form of a composite unit; and wherein only said first firmware has authority to access the first



storage medium driven by said first drive, and only said second firmware has authority to access the second storage medium driven by said second drive ( Inherent, since each driver ( software/firmware ) would be able ( have authority ) to run its respective media having an ID and access the information on it ).

In the following claim Ross et al show: " a predetermined key (Fig. 5 ( Enabler Key ) ", and do not explicitly show " storing in storage media ".

**Claim 8.** A license devolution method, comprising:

However, Hasebe et al teach the following except above mentioned " predetermined key ":

a) storing in a first storage medium contents encrypted with a predetermined key, a first media ID identifying the first storage medium, and encryption secure information generated by encrypting with the first media ID, the key and a first license information (See discussion in claim 1a) above), which represents a right to use the contents ( Fig. 4 ( s3, s6, s7 ) described col. 6, lines 3-43, Fig. 2 ( 12, 13, 14 ), col. 4, lines 10-15. Col. 5, lines 3-7 ).

"Storing" in computer art is notoriously known. It would have been obvious to one of ordinary skill in the art at the time of instant invention to advantageously use the available technique, because it would save time and money which would be spent on R&D).

Following steps are method steps of apparatus claim above, same rationale applies as to elements claim 1(a) and 1 (b) above.

b) decoding the first encryption secure information using the first media ID to obtain the key and first use information;

c) generating a second encryption secure information by encrypting with a second media ID, which identifies a second storage medium, the key and second use information, which represents a second right to use the contents that is devolved from the first storage medium to the second storage medium; and

storing the second encryption secure information in said second storage medium, wherein the right to use the contents stored in the first storage medium is devolved from the first storage medium to the second storage medium (Hasebe et al: Fig. 4 (s3, s6, s7), col. 6, lines 3-43 read with col. 4, lines 62-64, col. 9, lines 6-9 and motivation statement under Applicant's claim 1a) above ).

**Claim 9.** A license devolution system in communication with computer readable storages (Ross et al: Col. 2, lines 41-44 recited with lines 1-7 and col. 3, lines 6-11 (specifically lines 6-8, reciting: The present invention employs a scheme for creating, extracting, **transferring (devolving)**, enforcing and managing electronic licenses)), comprising:

a) an access unit accessing a first storage unit having a first storage ID and storing contents encrypted with a predetermined key and storing a first encryption secure information generated by encrypting the key and a first license information, which represents a right to use the contents, with the first storage ID, and accessing a second storage unit having a second storage ID identifying the second storage unit

Art Unit: 3623

(See the discussion of Applicant's claim 1a) above. Applicant will appreciate that reference's accessing function clearly points to the presence of "an access unit" in the system);

b) a decoder decoding the first encryption secure information stored in said first storage unit using the first storage ID to obtain the key and the first license information (See the discussion of Applicant's claim 1b) above); and

c) a devolving unit devolving the right to use the contents of the first storage unit to the second storage unit by generating a second licensed information, which represents a second right to use the contents devolved from the first license information stored on the first storage unit to the second storage unit, and encrypting the key and the second use information with the second storage ID to generate a second encryption secure information stored in said second storage unit. Applicant will appreciably realize that reference's "transferring function-col. 3, line 7", clearly shows the presence of a transferring (devolving) unit. Moreover, reference's encryption function (Col. 3, lines 15-16) clearly directs to the presence of encryption unit which would be used as a devolving unit as per Applicant's Remarks, last lines under NEW CLAIM which read: The "devolving unit" of new claim 9 **can** correspond to encryption means 22 in Fig. 1).

### ***Response to Arguments***

7. Applicant's arguments filed February 28, 2003 have been fully considered, but the same are not persuasive.

Applicant in Remarks argues that:

a) The terms "Licensing" and "devolution" are not same; "License means "grant of rights" or "authorization", but "devolution" means transfer of such license rights or authorization to another, i.e., another licensee (Page 5, lines 5-7)"

In this regard, Applicant will appreciably realize that Applicant's description of the distinction between the terms is not totally clear. Examiner's interpretation in this respect is that the two terms can be used interchangeably.

b) Ross et al and Hasebe et al do not teach Applicant's invention: "Ross does not relate to "devolution". Ross does not disclose or suggest using transferee (licensee) information to protect the license information, because Ross does not give up or relinquish ownership of anything, i.e., does not involve "devolution" (Page 4, lines 17-20); and "Hasebe discloses use of a medium key 12, yet does not accommodate "license devolution" (Page 6, lines 1-3 under heading HASEBE)"

In this respect, Applicant is reminded that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

c) Pinard and Stefik do not teach the Applicant's invention: "Although, Pinard and Stefik disclose the concept of "devolution" they are silent and do not suggest the present invention's idea of "devolving" a license and protecting the devolved license information using media ID of a transferee (licensee) that will be storing the devolved license information (Page 6, lines 6-9, under heading PINARD AND STEFIK)".

Regarding above, Applicant ought to appreciably realize that Ross et al and Hasebe et al teach or suggest Applicant's invention; however, Pinard and Stefik references were cited simply in support of Examiner's standpoint that "devolution or devolving" is "old and well known".

In the light of above mentioned facts, Examiner respectfully states that applicant's arguments have been fully considered, deemed unpersuasive and the rejections under prior Office Action, Paper No. 21, mailed November 01, 2002 are maintained.

### ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 3623

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Irshadullah whose telephone number is (703) 308-6683. The examiner can normally be reached on M-F from 11:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz, can be reached on (703) 305-9643. The fax number for the organization is (703) 305-7687.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-3900.

  
M. Irshadullah

May 14, 2003

  
TARIQ R. HAFIZ  
SUPERVISORY PATENT EXAMINER  
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